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Filed : May 31, 2000

REMARKS

Response to Rejection of Claims 1-10 Under 35 U.S.C. § 103(a)

In the September 17, 2003 Final Office Action, the Examiner maintains the previous rejection of Claims 1-10 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication No. 2002/0072965 A1 of Merriman et al. ("Merriman") in view of U.S. Patent No. 6,339,761 issued to Cottingham ("Cottingham"). The Examiner states that Merriman teaches all the limitations of Claims 1-5 except for "wherein the personal computers are configured to periodically receive and store advertising content and display the advertising content while or before bootloading a user selected application environment." The Examiner also indicates that Merriman teaches all the limitations of Claims 6-10 except for "wherein the advertising data is formatted for storage and display in the network of personal computers while or before the network of personal computers bootload a selected application environment." The Examiner further states that the limitations of Claims 1-10 not found in Merriman are taught by Cottingham and that it would have been obvious to one of ordinary skill in the art to modify Merriman by including these limitations from Cottingham.

Applicant asserts that the combination of Merriman and Cottingham is insufficient to reject Claims 1-10 as unpatentable under 35 U.S.C. § 103(a). In support of this assertion, Applicant respectfully resubmits the remarks made in support of the patentability of Claims 1-10 in response to the March 28, 2003 Office Action, and such remarks are incorporated in their entirety by reference herein. As discussed in detail below, Applicant respectfully submits that Claims 1-10 include limitations that are not taught, disclosed, or suggested by either Merriman or Cottingham. Applicant further submits that the Examiner has not provided a *prima facie* case of obviousness since the Examiner did not point to a motivation to combine the two references in the prior art. Therefore, Claims 1-10 are patentably distinguished over Merriman in view of Cottingham.

Claim limitations missing from both cited references

Applicant respectfully submits that Cottingham does not teach, disclose, or suggest the limitations of Claims 1-10 that the Examiner acknowledges are missing from Merriman. In

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particular, Cottingham does not teach, disclose, or suggest the limitation of Claim 1 in which “the personal computers are configured to periodically receive and store advertising content and display the advertising content while or before bootloading a user selected application environment” (emphasis added). In addition, Cottingham does not teach, disclose, or suggest the limitation of Claim 6 in which “the advertising data is formatted for storage and display in the network of personal computers while or before the network of personal computers bootload a selected application environment” (emphasis added).

As explained by the present application, at page 4, lines 16-19 (emphasis added):

the advertisement data is formatted for display at the personal computers while or before the bootloading of a user selected application environment. ... The advertising data is then stored into an advertising database 320.

Furthermore, as explained at page 4, line 31 - page 5, line 2 (emphasis added):

As defined herein, bootloading of a user selected application environment comprises executing one or more programs to configure a personal computer to a state wherein the personal computer can execute an application program specified by the user after boot up.

The present application further explains at page 9, lines 8-14 (emphasis added):

Advantageously, advertisement data may be presented to a user during a period in which the user normally receives sterile information regarding the boot process. Typically, during the boot process, a user performs non-computer related activities, or alternatively, stares blankly at the screen. Using the present invention, advertisers can display advertisement content to a user while the bootloading process is occurring. In many instances, the boot process is repeated daily and represents a significant opportunity for presenting advertising which can be informative and entertaining during an otherwise unproductive time span.

In this way, the present application describes a content delivery system and a corresponding method for distributing advertising to personal computer users during or before bootloading to beneficially engage the user during an otherwise unproductive time while the user waits for the computer to boot up.

In contrast, Cottingham (as well as Merriman) discloses displaying advertising after the user's computer has booted up and is running an active browser. Cottingham discloses a system and method in which an Internet Service Provider (“ISP”) customer requests information from a

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content provider (e.g., a web-page requested using an active browser), and the ISP communicates an advertisement to the ISP customer immediately before communicating the requested information. Nowhere does Cottingham teach, disclose, or suggest receiving and storing advertising content and displaying the advertising content while or before bootloading a user selected application environment. Therefore, independent Claims 1 and 6 are patentably distinguished over Merriman in view of Cottingham.

Claims 2-5 depend from Claim 1, and include the limitations of Claim 1 that are not taught, disclosed, or suggested by Merriman in view of Cottingham. Claims 7-10 depend from Claim 6, and include the limitations of Claim 6 that are not taught, disclosed, or suggested by Merriman in view of Cottingham. Furthermore, each of Claims 2-5 further recites limitations of particular utility in addition to the limitations of Claim 1 and each of Claims 7-10 further recites limitations of particular utility in addition to the limitations of Claim 6. Therefore, Applicant submits that Claims 2-5 and 7-10 are patentably distinguished over Merriman in view of Cottingham.

No motivation to combine the two references

In addition, Applicant submits that the Examiner has not presented a *prima facie* case of obviousness of Claims 1-10 because the Examiner has not provided a motivation in the prior art to combine Merriman and Cottingham.

Obviousness can only be established where there is some teaching, suggestion, or motivation to combine or modify the teachings of the prior art to produce the claimed invention. See In re Fine, 837 F.2d 1071 (Fed. Cir. 1988); M.P.E.P. Section 2143.01, page 2100-125, February 2003 revision. To support the Examiner's assertion of obviousness, the Examiner must provide clear and particular findings as to the reason one skilled in the art, with no knowledge of the claimed invention, would have selected these components and combined them in the manner claimed. See, e.g., In re Kotzab, 217 F.3d 1365, 1371 (Fed. Cir. 2000); In re Dembiczak, 175 F.3d 994, 999 (Fed. Cir. 1999).

The Examiner states that it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Merriman to include the teachings of

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Cottingham. The Examiner further states that such a combination would have allowed advertisers to track consumer response to specific elements of the web page/application environment as well as to better infer information about the user's interests in an effort to qualify the user prior to presenting subsequent advertising.

However, neither cited reference provides any motivation for modifying Merriman to include the teachings of Cottingham. The Examiner has not identified any other prior art reference for the motivation to combine Merriman and Cottingham. Therefore, Applicant submits that the Examiner has not provided clear and particular findings in the prior art for a motivation to combine Merriman and Cottingham. A *prima facie* case of obviousness can not be established by relying upon the claimed invention to provide the suggestion or motivation to combine. In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999). Applicant submits that the Examiner has impermissibly used hindsight by relying on the claimed invention for the motivation to combine Merriman and Cottingham. Therefore, Applicant submits that Claims 1-10 are patentably distinguished from the prior art. Applicant respectfully requests the Examiner to withdraw the rejection of Claims 1-10 and to pass Claims 1-10 to allowance.

Summary

For the foregoing reasons, Applicant respectfully requests the Examiner to withdraw the rejection of Claims 1-10 under 35 U.S.C. § 103(a). Applicant respectfully requests the Examiner to allow Claims 1-10 and to pass this application to the issue process. In view of the foregoing amendments and remarks, Applicant respectfully submits that Claims 1-10 are in condition for allowance, and Applicant respectfully requests allowance of Claims 1-10.

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Respectfully submitted,

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